

REMARKS

1 The Examiner objected to Figure 4 to the extent that it did not provide legends
required to explain the figure. Applicants submit herewith a replacement sheet
depicting Figure 4, which has been amended to include the requested legends.

5 The Examiner objected to the specification and claims 8, 9, 25 and 26 for the use
of the term "SIT tones" therein. Applicants have amended the specification and the
aforementioned claims by replacing the term "SIT tones" with "special information
tones." Claims 8, 9, 25 and 26 are believed to be in condition for allowance and the
Examiner is respectfully requested to reconsider and allow the same.

10 The Examiner rejected claims 1, 2 and 3 under 35 U.S.C. § 102(b) as being
anticipated by U.S. Patent No. 6,195,417 to Dans. Applicants respectfully disagree.
However, in an effort to expedite the prosecution of the present matter, applicants have
amended claim 1 to specifically claim that the software is operative on said processor
15 to: "play an audible message over said line that requests a specific response from a
callee on said line"; and "receive and identify audible sounds relative to said specific
response on said line after said audible message is played." Accordingly, claim 1
specifically requires software that is operative to **actively** prompt the callee for a
specific response, receive and identify audible sounds relative to the specific request
20 and then classify the telephone number according to the audible sounds. Dans teaches
a system that passively listens for certain audible sounds. Dans does not teach or
otherwise suggest a system that is operative to actively query the callee and categorize
the telephone number based on audible sounds received relative to the specific query.

1 Anticipation under 35 U.S.C. § 102 focuses on the questions of whether or not a
claim reads on the product or process disclosed by a prior art reference, not what the
reference broadly "teaches." Kalman v. Kimberly-Clarke Corp., 713 F.2d 760 (Fed. Cir.
1983). "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every
5 element of the claimed function must be identically shown in a single reference."
Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (Fed. Cir. 1988); Verdegaal
Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.
1987) (A claim is anticipated only if each and every element as set forth in the claim is
found, either expressly or inherently described, in a single prior art reference). The
10 differences between the Dans system and the applicants' system, as claimed in claim 1,
are significant. Accordingly, claim 1 is believed to be allowable over the prior art.
Claims 2-3 each depend from claim 1 and are believed to be allowable for at least the
reasons set forth herein with respect to claim 1. Applicants respectfully request the
15 Examiner to reconsider the aforementioned rejections and allow claims 1-3.

The Examiner rejected claims 4-7, 10-24, 27 and 28 under 35 U.S.C. § 103(a) as
being unpatentable over the Dans patent, as applied to claim 1, further in view of U.S.
Patent No. 6,823,054 to Suhm et al. Applicants respectfully disagree. Claims 4 and 21
have been cancelled. Claim 1 has been amended, as set forth hereinabove, and is
20 believed to be allowable. Claims 5-7, 10-20, 22-24, 27 and 28 each ultimately depend
from claim 1 and are believed to be allowable for at least the reasons set forth with
respect to claim 1. Claim 1 includes limitations originally found within claim 4 (that the
software is operative to "play an audible message over said line that requests a specific
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1 response from a callee on said line"). The remainder of the limitations within claim 1
(from which claim 4 originally depended) clearly show that the limitations were such that
the software is operative to actively prompt the callee for a specific response, receive
and identify audible sounds relative to the specific request and then classify the
telephone number according to the audible sounds. This is not taught or otherwise
suggested within the prior art. Dans is discussed hereinabove. Suhm, et al. teach a
system for performing a comprehensive usability assessment of telephone
interfaces, which is based on call recordings. Neither Suhm et al. nor Dans teach
systems that are operative to actively prompt callees in the process of classifying lists of
telephone numbers, which is how claim 1 specifically claims that the software is
operatively configured.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three
basic criteria must be met. First, there must be some suggestion or motivation, either in
the references themselves or in the knowledge generally available to one of ordinary
skill in the art, to modify the reference or to combine reference teachings. Second,
there must be a reasonable expectation of success. Finally, the prior art reference must
teach or suggest all the claimed limitations. The teaching or suggestion to make the
claimed combination and the reasonable expectation of success must both be found in
the prior art and not based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20
USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. None of these required elements can
be found in this matter. The claimed software operations and combined elements are
not disclosed or otherwise suggested by the prior art. As such, there is no suggestion

1 or motivation, either in the references themselves or in the knowledge generally
available to one of ordinary skill in the art, to modify the references as claimed by the
Examiner. Without all the component characteristics, no success can be expected from
the Examiner's modifications to the prior art systems.

5 The Examiner is not considering the claimed invention or the prior art as a whole.
In determining the difference between the prior art and the claims, the question under
35 U.S.C. § 103 is not whether the differences themselves would have been obvious,
but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc.
v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A prior art
10 reference and the claimed invention must be considered in their entireties. Distilling an
invention down to the "gist" or "thrust" of an invention disregards the requirement of
analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc. v. Garlock,
Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S. 851
15 (1984). A system that uses software to actively prompt a callee for a specific
response, receive and identify audible sounds relative to the specific request and then
classify the telephone number according to the audible sounds is clearly unique to the
art. No suggestion or motivation can be found within the art for such a system.

20 The prior art must suggest the desirability of the claimed invention. There are
three possible sources for a motivation to combine references: the nature of the
problem to be solved, the teachings of the prior art, and the knowledge of persons of
ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58
(Fed. Cir. 1998) (Stating that the combination of the references taught every element of
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1 the claimed invention, however without a motivation to combine, a rejection based on a
2 *prima facie* case of obviousness was held improper). Obviousness can only be
3 established by combining or modifying the teachings of the prior art to produce the
4 claimed invention where there is some teaching, suggestion or motivation to do so,
5 found either explicitly or implicitly in the references themselves or in the knowledge
6 generally available to one of ordinary skill in the art. The test for an implicit showing is
7 what the combined teachings, knowledge of one of ordinary skill in the art, and the
8 nature of the problem to be solved as a whole would have suggested to those of
9 ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317
10 (Fed. Cir. 2000) (While the control of multiple valves by a single sensor rather than by
11 multiple sensors was a "technologically simple concept," there was no finding "as to the
12 specific understanding or principle within the knowledge of the skilled artisan" that would
13 have provided the motivation to use a single sensor as the system to control more than
14 one valve). Similarly, in this matter, the concept is simple. However, no suggestion or
15 motivation can be found within the references individually or together for the active
16 operation of the system in the classification of telephone numbers.

17 Furthermore, the fact that references can be modified is not sufficient to establish
18 *prima facie* obviousness. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).
19 Although a prior art device "may be capable of being modified to run the way the
20 apparatus is claimed, there must be some suggestion or motivation in the reference to
21 do so." Id. Also, "a statement that modifications of the prior art meet the claimed
22 inventions would have been 'well within the ordinary skill of the art' at the time the
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1 claimed invention was made because the references relied upon teach that all aspects
of the claimed invention were individually known in the art' is not sufficient to establish a
prima facie case of obviousness without some objective reason to combine the
2 teachings of the references." Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. &
5 Inter. 1993); see also, In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed.
Cir. 2000) (The court reversed an obviousness rejection involving a technologically
simple concept because there was no finding as to the principle or specific
understanding within the knowledge of a skilled artisan that would have motivated the
skilled artisan to make the claimed invention).

10 Regarding claim 5, the Examiner indicates that Suhm, et al. teach a call
termination mode that responds to an automated message. However, Suhm, et al. do
not teach a system request for the callee to terminate the call, followed by detection of
whether or not the call was terminated, followed by a classification of the telephone
15 number called according to the response or non-response of the callee (claims 6 and 7).
The combined teachings of the prior art do not come close to teaching all of the
elements of such a system, let alone their claimed combination.

20 The Examiner rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being
unpatentable over the Dans patent and further in view of U.S. Patent Application
Publication No. US 20030086541 to Brown et al. Similarly, claims 25 and 26 were
rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the
Dans and Suhm et al. patents, as applied to claim 19, and further in view of the Brown
et al. patent application. Claims 8, 9, 25 and 26 each ultimately depend from claim 1

and are believed to be allowable for at least the reasons set forth with respect to claim

1. Moreover, Brown, et al. do not teach a system request for the callee, followed by detection of audible sounds (including SIT tones), followed by a classification of the telephone number called according to the audible sounds received. The combined teachings of the prior art do not come close to teaching all of the elements of such a system, let alone their claimed combination. The fact that Brown, et al. teach a tone detector is not evidence of the motivation of one skilled in the art to use the SIT tone detection in the claimed manner.

Claims 1-3,5-20 and 22-28 are believed to be allowable for at least the reasons set forth herein. The Examiner is respectfully requested to reconsider and allow the pending claims in this matter.

No fees or extensions of time are believed to be due in connection with this amendment; however, please consider this a request for any additional extension inadvertently omitted, and charge any additional fees to Deposit Account No. 502093.

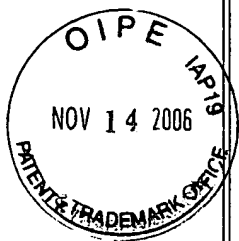
Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for JAMES M. HAYES, ET AL., Serial No. 10/809,736, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10th day of November, 2006.


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